

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPELLANT: Wyatt

EXAMINER: Dixon

SERIAL NO.: 09/544,508

GROUP ART UNIT: 3639

FILING DATE: April 6, 2000

ATTY. DKT. NO.: MCO-P-00-001

INVENTION: "A METHOD AND SYSTEM FOR PROVIDING BED AVAILABILITY INFORMATION ON A COMPUTER NETWORK"

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

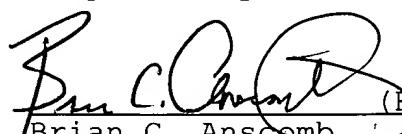
APPELLANT'S REPLY BRIEF

SIR:

Appellant submits herewith Appellant's Reply Brief in response to the Examiner's Answer mailed May 25, 2006.

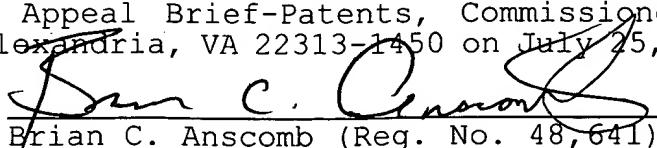
Appellant submits that no fee is required for submission of this Reply Brief. However, the Commissioner is hereby authorized to charge any fees which may be required, or to credit any overpayment to Deposit Acct. No. 50-0595. A duplicate of this sheet is enclosed for this purpose.

Respectfully submitted,


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CERTIFICATE OF MAILING

I hereby certify that this **REPLY BRIEF** is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Mail Stop Appeal Brief-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on July 25, 2006.


Brian C. Anscomb (Reg. No. 48,641)



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S I R:

This Reply Brief is submitted in response to the Examiner's Answer mailed May 25, 2006.

I. STATUS OF CLAIMS

Claims 1-10 and 14-19 are pending in this patent application. Claims 1-10 and 14-19 were finally rejected by the Examiner in a Final Rejection dated August 3, 2004 and are hereby on appeal.

II. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. Would Claims 1, 2, 4-9, 14-17 and 19 have been obvious under 35 U.S.C. §103(a) to one having ordinary skill in the art at the time of Appellant's invention over *Ohrn* (U.S. Patent No. 6,356,874) in view of *Stanis et al.* (U.S. Patent No. 4,135,241)?

III. ARGUMENT

In the Examiner's Answer, new points of argument were raised by the Examiner.

A. THE CITED REFERENCE AND REJECTION OF CLAIMS 1, 2, 4-9, 14-17 AND 19

Claims 1, 2, 4-9, 14-17 and 19 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Ohrn* (U.S. Patent No. 6,356,874) in view of *Stanis et al.* (U.S. Patent No. 4,135,241). In the Final Rejection, the Examiner stated:

As per Claim 1, 14.
Ohrn ('874) discloses:
providing a network, see column 7, lines 60-66 and figure 1;
providing a database connected to the computer network, see figure 1;
inputting bed availability information for a plurality of healthcare facilities, wherein each of the plurality of healthcare facilities have beds and further wherein the bed availability information is input into the database and is accessible by the computer network, see column 6, lines 6-45, column 7, lines 60-66 and column 10, lines 22-30;
providing a first access to the database for determining the available bed for the patient by a user of the database, see column 6, lines 6-45 and column 21, lines 29-34
searching the bed availability information for the plurality of healthcare facilities in the database, see column 5, lines 37-63
determining the available bed based on user preferences, see column 5, lines 37-63.
Ohrn ('874) does not specifically disclose entering individual medical condition of a patient and searching [sic] [or] matching the bed to the condition.
Stanis et al. ('241) [sic] [teach] searching for availability of beds and the information about the bed, including data regarding the nursing station to which it is associated, and matching, see column 3, lines 14-25 and column 21, lines 29-34 for the benefit of managing the status of beds in a hospital.

B. OHRN IN VIEW OF STANIS ET AL., TAKEN SINGLY OR IN COMBINATION, DO NOT TEACH OR SUGGEST THE INVENTION DEFINED IN CLAIMS 1, 2, 4-9, 14-17 AND 19 UNDER 35 U.S.C. §103(a)

Independent Claim 1 requires the step of inputting bed availability information for a plurality of healthcare facilities

wherein each of the plurality of healthcare facilities have beds for providing a plurality of types of medical care. Moreover, Claim 1 requires the step of matching the medical condition of the patient in the database to one of the types of medical care to obtain the bed availability information of the plurality of healthcare facilities.

Independent Claim 14 requires a means for inputting bed availability information of a plurality of healthcare facilities into the database. Further, Claim 14 requires a means for comparing the information of the patient in the database to the bed availability information in the database to obtain each of the plurality of healthcare facilities treating the patient.

Neither *Ohrn* nor *Stanis et al.*, taken singly or in combination, teaches or suggests the step of inputting bed availability information for a plurality of healthcare facilities wherein each of the plurality of healthcare facilities have beds for providing a plurality of types of medical care as required by Claim 1. Further, neither *Ohrn* nor *Stanis et al.*, taken singly or in combination, teaches or suggests means for inputting bed availability information of a plurality of healthcare facilities into the database as required by Claim 14.

The Examiner admits Appellant's argument that "Stennis et al. teach only one healthcare provider rather than a plurality of providers is convincing". See Examiner's Answer, page 6. However, the Examiner alleges "*Ohrn* is relied upon to teach the plurality of providers, see column 5, lines 37-41 (those hotels with vacant

rooms), [and] *Stanis et al.* is relied upon for the teaching of the healthcare providers with vacant rooms". See Examiner's Answer, page 6. The Examiner further admits *Stanis et al.* merely teach only one healthcare provider. In addition, *Stanis et al.* merely teach "a search is made for all bed numbers in locations containing a specified nursing station number and control characters indicating a need for special attention or service". See column 21, lines 25-28. The Examiner further admits that *Ohrn* merely teaches hotels having a plurality of vacant rooms. Moreover, *Ohrn* merely teaches that a "voice network interface will read out the relevant service offers, i.e. those hotels which have vacant rooms". See column 5, lines 39-41. Therefore, neither *Stanis et al.* nor *Ohrn*, taken singly or in combination, teaches or suggests the novel steps and the structural elements as required by Claim 1 and 14.

More specifically, neither *Ohrn* nor *Stanis et al.*, taken singly or in combination, teaches or suggests the step of matching the medical condition of the patient in the database to one of the types of medical care to obtain the bed availability information of the plurality of healthcare facilities as required by Claim 1. Moreover, neither *Ohrn* nor *Stanis et al.*, taken singly or in combination, teaches or suggests a means for comparing the information of the patient in the database to the bed availability information in the database to obtain each of the plurality of healthcare facilities treating the patient as required by Claim 14.

The Examiner admits *Ohrn* fails to teach or suggest matching the medical condition of the patient in the database to one of the types of medical care to obtain bed availability information as required by Claim 1. The Examiner alleges it would have been obvious in view of *Stanis et al.* to include matching patient conditions to available beds for the benefit of accurately placing patients in the correct ward. On the contrary, nowhere does *Stanis et al.* teach or suggest inputting a medical condition of the user to determine the bed availability for the user with the medical condition as required by Claim 1. *Stanis et al.* merely teach that "other sections [of the bed information storage area] are used to store temporary information pertaining to the status of the bed (clean, ready, occupied, etc.) and information as to who is the current occupant of the bed". (See *Stanis et al.*, column 7, lines 47-51).

Still further, the Examiner admits *Ohrn* fails to teach or suggest a means for comparing the information of the patient in the database to the bed availability information in the database to obtain each of the plurality of healthcare facilities treating the patient as required by Claim 14. The Examiner alleges it would have been obvious in view of *Stanis et al.* to include comparing patient conditions to available beds for the benefit of accurately placing patients in the correct ward. Therefore, neither *Stanis et al.* nor *Ohrn*, taken singly or in combination, teaches or suggests the novel steps and the structural elements as required by Claims

1 and 14.

Moreover, a person of ordinary skill in the art would never have been motivated to combine *Ohrn* with *Stanis et al.* in the manner suggested by the Patent Office in formulating the rejection under 35 U.S.C. §103(a). Appellant submits that the Patent Office is merely "piece-mealing" references together, providing various teachings and positively defined limitations of Appellant's method and system for providing bed availability information to deprecate the claimed invention. Of course, hindsight reconstruction of Appellant's invention is impermissible. Appellant respectfully submits that Claims 1 and 14 distinctly define the present invention from *Ohrn* and/or *Stanis et al.*, taken singly or in combination.

With the analysis of the deficiencies of *Ohrn* and *Stanis et al.* in mind, no reason or suggestion in the evidence of record exists why one of ordinary skill in the art would have been led to combine *Ohrn* and *Stanis et al.* in the manner suggested by the Patent Office in formulating the rejections under 35 U.S.C. §103. Therefore, *prima facie* obviousness has not been established by the Patent Office as required under 35 U.S.C. §103.

It is submitted that the question under §103 is whether the totality of the art would collectively suggest the claimed invention to one of ordinary skill in this art. *In re Simon*, 461 F.2d 1387, 174 USPQ 114 (CCPA 1972).

Appellant further submits that one having ordinary skill in

the art at the time of Appellant's invention would never have been motivated to modify *Ohrn* with *Stanis et al.* in the manner suggested by the Examiner in formulating the rejections under 35 U.S.C. §103(a).

That elements, even distinguishing elements, are disclosed in the art is alone insufficient. It is common to find elements somewhere in the art. Moreover, most, if not all, elements perform their ordained and expected functions. The test is whether the invention as a whole, in light of all the teachings of the references in their entireties, would have been obvious to one of ordinary skill in the art at the time the invention was made. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1545, 220 USPQ 193 (Fed. Cir. 1983).

Appellant submits that the Examiner has merely located components of Appellant's claimed invention. However, that the art disclosed components of Appellant's claimed invention, either separately or used in other combinations, is insufficient. A teaching, suggestion, or incentive must exist to make the combination made by Appellant. *Interconnect Planning Corp. v. Feil*, 774 F. 2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1988).

Even assuming that one having ordinary skill in the art could somehow have combined *Ohrn* and *Stanis et al.* as set forth by the Examiner, the resultant combination still lacks the critical steps and elements positively recited in Claims 1 and 14, respectively.

In view of the foregoing, Appellant submits that the rejection

of Claims 1 and 14 under 35 U.S.C. §103(a) is improper and should be reversed. Since Claims 2 and 4-9 set forth additional novel steps of Appellant's method as defined by Claim 1, and Claims 15-17 and 19 set forth additional structural elements of Appellant's system as defined by Claim 14, the rejection of Claims 2, 4-9, 15-17 and 19 is improper and should be reversed.

**C. CLAIM 14 DOES NOT MERELY STATE THE MANNER OF USE
BUT IS STRUCTURALLY LIMITED BY THE ELEMENTS OF CLAIM 14**

With regard to Claim 14, the Examiner, citing *Ex Parte Masham*, 2 USPQ 2d 1657 (BPAI 1987), alleges "a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus". Appellant submits the Examiner has disregarded the claimed subject matter as a whole. Furthermore, the Examiner has attempted to distill Appellant's claimed invention directed to a system for storing and accessing bed availability information to merely what the Examiner has characterized as "a network, a database, an input means, means for searching, comparing, matching and retrieving". See Examiner's Answer, page 8.

Still further, *In re Masham* is distinguishable. *In re Masham* merely determined that the apparatus was not patentably distinct from the prior art merely by the amount of material to be poured into the apparatus. 2 USPQ 2d 1657. Specifically, *In re Masham* related to the claimed limitation of a material to be worked upon in combination with an apparatus. *Id.* However, Claim 14 requires a means for inputting bed availability information of a plurality

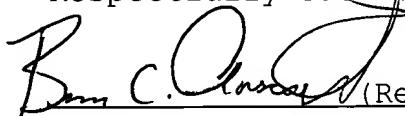
of healthcare facilities into the database and means for accessing the bed availability information and retrieving the bed availability information from the database via the computer network. Further, Claim 14 requires a means for inputting information of the patient into a form via the computer network wherein the information of the patient is stored in the database. Still further, Claim 14 requires comparing the information of the patient in the database to the bed availability information in the database to obtain each of the plurality of healthcare facilities treating the patient.

Appellant submits inputting bed availability information and information of the patient into the database structurally limits Claim 14 and does not merely define a method of using any database or computer network. Therefore, the Examiner's rejection of Claim 14 as merely reciting the manner of use is improper.

IV. CONCLUSION

In view of the foregoing remarks, Appellant respectfully submits that all of the claims in the application are in allowable form and requests the Board to reverse the rejections of the Examiner.

Respectfully submitted,


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